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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,905	11/30/2000	Charles Scott Roberson	M-8391US	3691
33031 7590 12/27/2006 CAMPBELL STEPHENSON ASCOLESE, LLP 4807 SPICEWOOD SPRINGS RD. BLDG. 4, SUITE 201 AUSTIN, TX 78759			EXAMINER PHAN, MAN U	
			ART UNIT	PAPER NUMBER
			2616	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/727,905

Applicant(s)

ROBERSON ET AL.

Examiner

Man Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The application of Roberson et al. for a "Method and apparatus for transporting network management information in a telecommunications network" filed 11/30/2000 has been examined. Responsive to the restriction requirement filed on 10/27/2006, affirmation of the election has been made by applicant, and a provisional election was made without traverse to prosecute the invention of group II, claims 56-72. Claims 32-55 are withdrawn from further consideration by the Examiner, 37 C.F.R. ' 1.142(b), as being drawn to a non-elected invention. Claims 56-72 are pending in the application.

Specification

2. The disclosure is objected to because of the following informalities:
In the cross reference to related applications section, The status of the related application USSN#09/478,287, 09/343,122 and 09/274,078 noted on page 1, lines 15-25 need to be updated. These applications are now US Patent# 6,614,785, US#6,657,969 and US#6,587,470 respectively. Appropriate correction is required.

3. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols @, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is

strongly encouraged to aid in this endeavor.

Claim Rejections - 35 USC ' 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 68-72 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 68-72 are directed to “a computer program product” which is not supported by either a specific asserted utility or a well established utility. Claims 68-72 merely defines “*a computer program product*” or “*data record for storing instructions*”, and is not directed to statutory subject matter. The claims appear to be nothing more than a signal not tangibly embodied in a manner so as to be executable and thus non-statutory for failing to be in one of the categories of invention. It’s not tangibly embodied and non-functional descriptive material - data per se. Therefore, what applicant is attempting to claim as a computer program product or data record as is known in the art. The claim is actually drawn to non-functional descriptive material stored on a machine readable medium. The description given in the specification does not cure this problem. In practical terms, claims define non-statutory processes if they simply manipulate abstract ideas, e.g., a bid or a bubble hierarchy, without some claimed practical application, *Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59; *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759.

Claims 68-72 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established

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utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

6. The following is quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 56, 62 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Thrysoe (US#6,574,238).

Regarding claim 62, Thrysoe discloses a system and method of transporting frame information across a network, comprising: placing payload information from a first frame into payload locations of a second frame, the first frame associated with a first network having a first protocol, the second frame associated with a second network having a second protocol (See Fig. 1 and Col. 1, lines 35-40; Col. 2, lines 12-17). Thrysoe discloses data frames being exchanged between local area networks using an inter-switch link, where the inter-switch link receives encapsulated native LAN data frames, where the payload segment in the received data frame is an encapsulated Frame; placing overhead information from the first frame into payload locations of a payload for the second frame (Thrysoe, Col. 2, lines 12-17, and Col. 5, line 45 through Col. 6, line 10).

Regarding claims 56, It's method claim corresponding to the apparatus claim 62 above. Therefore, claim 56 is analyzed and rejected as previously discussed with respect to claim 62.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 57-61 and 63-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thrysoe (US#6,574,238) in view of Upp et al. (US#4,967,405).

With respect to claims 63, 64, 66, Thrysoe (US#6,574,238) and Upp et al.(US#4,967,405) disclose a novel method and system for transporting frame information across network, according to the essential features of the claims. Thrysoe teaches the limitations, substantially as claimed, as described in claim 62 - paragraph 7 above, including wherein a consistent frame format is used by modifying overhead bytes. However, Thrysoe does not explicitly state wherein

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the means for receiving a plurality of time slots and cross connecting the time slots. In an analogous art of processing signals in SONET format, Upp et al. (US#4,967,405) discloses a virtual tributary cross-connect module which cross-connects virtual tributary payloads in space, time, and phase to generate new substantially SONET formatted signals; a wide band cross-connect module (Col. 2, lines 52 plus).

Regarding claims 65, 67, Upp et al. (US#4,967,405) further discloses in Fig. 2b block diagram of the receive side of the scrambler/descrambler SONET24/3 mux/demux component, in which input buffer 280 stores the incoming data and retransmits it to a descrambling means 282 (Upp, col. 2, lines 19-25 and Col. 9, lines 24 plus).

Regarding claims 57-61, they are method claims corresponding to the apparatus claims 63-67 above. Therefore, claims 57-61 are analyzed and rejected as previously discussed with respect to claims 63-67.

One skilled in the art would have recognized the need for effectively and efficiently transporting network management information between network elements, and would have applied Upp's non-blocking system for cross connecting high speed digital SONET signals into Thrysor's novel use of frame-based communications link used to interconnect two or more network elements. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Upp's system for cross-connecting high speed digital SONET signals into Thrysoe's inter-switch link header modification with the motivation being to provide a method and system for transporting a variety of native frame types including SONET format for the benefit of providing management information between network elements.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Champion, Jr. et al. (US#6, 731,654) is cited to show the Communication system overhead channel.

The Davis et al. (US#2002/0004828) is cited to show the Element management system for heterogeneous telecommunications network.

The Davis et al. (US#6,260,062) is cited to show the Element management system for heterogeneous telecommunications network.

The Hurren et al. (US#6,788,681) is cited to show the virtual private networks and method for their operation.

The Raza et al. (US#6,870,813) is cited to show the Architectures for evolving traditional service provider networks and methods of optimization therefor.

The Pankaj (US#6,847,644) is cited to show the Hybrid data transport scheme over optical networks.

The Stewart et al. (US#6,389,036) is cited to show the Airlink transport container.

The Tatu (US#6,795,917) is cited to show the Method for packet authentication in the presence of network address translations and protocol conversions.

The Atsuki et al. (US#6,674,771) is cited to show the Transmission method and apparatus for transmitting low-speed SDH signals using a high-speed SDH frame.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Man U. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached Monday through Friday from 6:00 am to 3:00 pm.

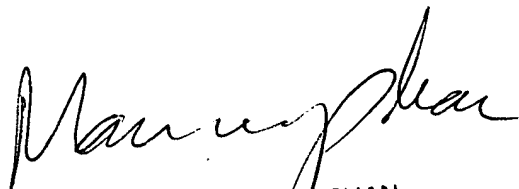
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

MPhan

12/19/2006


MAN U. PHAN
PRIMARY EXAMINER